UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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FENWICK & WEST LLP
SILICON VALLEY CENTER
801 CALIFORNIA STREET
MOUNTAIN VIEW, CA 94041

EXAMINER
GILLIGAN, CHRISTOPHER L

ART UNIT	PAPER NUMBER
3626	

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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/825,604	AQUILA ET AL.
	Examiner	Art Unit	
	Luke Gilligan	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>07 November 2005</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>15-72</u> is/are pending in the application.

   4a) Of the above claim(s) <u>15-24 and 36-72</u> is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>25-35</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

Election/Restrictions

1.   Applicant's election of claims 25-35 in the reply filed on 11/7/05 is acknowledged.

Because applicant did not distinctly and specifically point out the supposed errors in the

restriction requirement, the election has been treated as an election without traverse (MPEP

§ 818.03(a)).

Response to Amendment

2.   In the amendment filed 11/7/05, the following has occurred: claims 1-24 and 36-72 have

been withdrawn. Now, claims 25-35 are presented for examination.

Claim Rejections - 35 USC § 101

3.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

4.   Claims 33-35 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter.

5.   Claim 33 is directed to storing data associated with a plurality of insurance claims.

However, the recited steps of merely receiving data insurance claim systems and storing the

data in a particular format defines nothing more than functional descriptive material in the form

of a data structure *per se*. Therefore, because the claimed data structure is in no way tangible

embodied, claim 33 is directed to non-statutory subject matter (see MPEP 2106).

6.   In addition, claims 34 and 35, which depend from claim 33, are also directed to

functional descriptive material and, therefore, are non-statutory subject matter.

Claim Rejections - 35 USC § 112

7.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

8.   Claims 28-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite

for failing to particularly point out and distinctly claim the subject matter which applicant regards

as the invention.

9.   Claim 28 recites the phrase "a subset of the retrieved profiles" at line 9. Because claim

28 does not recite any step of retrieving profiles, nor is there any recitation of even a plurality of

profiles, this phrase lacks proper antecedent basis in the claim. It is also unclear what the

subset refers to given this lack of antecedent basis. For Examination purposes, the Examiner

will disregard this aspect of the recited limitations and only address the limitations directed to

the "profile of a potential assignee."

10.   Claims 29-32 are rejected for the same reasons as claim 28 through dependency.

Claim Rejections - 35 USC § 102

11.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by
> another filed in the United States before the invention by the applicant for patent or (2) a patent
> granted on an application for patent by another filed in the United States before the invention by the
> applicant for patent, except that an international application filed under the treaty defined in section
> 351(a) shall have the effects for purposes of this subsection of an application filed in the United States
> only if the international application designated the United States and was published under Article 21(2)
> of such treaty in the English language.

12.   Claims are rejected under 35 U.S.C. 102(e) as being anticipated by Borghesi et al., U.S.

Patent No. 5,950,169.

13.   As per claim 25, Borghesi teaches a computer implemented method of determining a

type of assignee to whom to assign an insurance claim, the method comprising: receiving data

related to the insurance claim, the data comprising a plurality of data elements, a data element

serving as an assignment criterion (see column 9, lines 22-29); determining a score of a data

element, the score responsive to scoring rules (see column 13, lines 18-20; the Examiner

interprets the "threshold total valuation number" to be a type of score as recited); determining a

score of the insurance claim responsive to a score of at least one data element (see column 13,

lines 18-20); determining a priority of the insurance claim according to the score of the

insurance claim (see column 13, lines 14-18; the Examiner interprets the determination that total

cost is approaching the threshold to be a type of determining a priority as recited); determining a

class of the insurance claim according to classing rules (see column 12, lines 14-19 and column

13, lines 12-15; the Examiner interprets the type of vehicle to be a type of the recited class since

it is used to determine values for the claim); and determining a type of assignee to whom to

assign the insurance claim according to the application of business rules to the score of the

insurance claim and the class of the insurance claim, wherein the business rules weight the

class more highly than the score (see column 13, lines 49-53).

14.   As per claim 26, Borghesi teaches the method of claim 25 as described above.

Borghesi further teaches determining an order in which to process the insurance claim

according to the application of a business rule to the priority of the insurance claim (see column

12, lines 16-19).

15.   As per claim 27, Borghesi teaches the method of claim 25 as described above.

Borghesi further teaches a type of assignee comprises one of repair facility, independent

appraiser, staff appraiser, and rental car provider (see column 9, lines 24-29).

16.   As per claim 28, Borghesi teaches a computer implemented method of assigning an insurance claim to an assignee, the method comprising: receiving data related to the insurance claim, the data identifying a type of assignee to whom to assign the insurance claim (see column 9, lines 21-29); retrieving a profile of a potential assignee, the potential assignee being of the received type (see column 11, lines 5-7); determining a score of the retrieved profile according to the application of a business rule to the insurance claim data and the retrieved profile (see column 13, lines 12-20); determining the capacity of a potential assignee to accept the insurance claim (see column 13, lines 20-23); assigning the insurance claim to the determined potential assignee (see column 13, lines 49-53).

17.   As per claim 30, Borghesi teaches the method of claim 28 as described above. Borghesi further teaches retrieving a capacity of the potential assignee from a database, the database storing data about the potential assignee (see column 9, lines 25-30).

18.   As per claim 31, Borghesi teaches the method of claim 28 as described above. Borghesi further teaches estimating the capacity of the potential assignee responsive to a plurality of transaction data stored in a database (see column 12, lines 37-44).

19.   As per claim 32, Borghesi teaches the method of claim 28 as described above. Borghesi further teaches prior to assigning the insurance claim to the determined potential assignee, receiving authorization from a user to assign the insurance claim to the determined potential assignee, the user being the beneficiary of the insurance claim (see column 16, liens 43-49).

20.   As per claim 33, Borghesi teaches a computer implemented method of creating a database that stores data associated with a plurality of insurance claims, the method comprising: receiving data from a plurality of different insurance claim systems, the plurality of different insurance claim systems comprising a system to obtain initial insurance claim data (see

column 2, lines 41-43), a system to determine an assignee to whom to assign an insurance

claim (see column 6, lines 1-5), and a system to access, manage, and process insurance claim

data, the data comprising administrative information, estimate data, and transactional data (see

column 9, lines 18-33); and storing the data in a data format that is usable by a plurality of

insurance claim systems, the plurality of different insurance claim systems comprising a system

to obtain initial insurance claim data (see column 2, lines 41-43), a system to determine an

assignee to whom to assign an insurance claim (see column 6, lines 1-5), and a system to

access, manage, and process insurance claim data (see column 9, lines 18-33).

21.   As per claim 34, Borghesi teaches the method of claim 33 as described above.

Borghesi further teaches requesting data from the plurality of different insurance claim systems

prior to receiving data from the plurality of different insurance claim systems (see column 15,

line 64 – column 16, line 22).

22.   As per claim 35, Borghesi teaches the method of claim 33 as described above.

Borghesi further teaches storing a subset of the plurality of data in an uneditable format that

prevents a user from tampering with the data (see column 14, lines 9-22).

Claim Rejections - 35 USC § 103

23.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

24.   Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Borghesi et al.,

U.S. Patent No. 5,950,169 in view of Brooks et al., U.S. Patent No. 6,950,801.

25.   As per claim 29, Borghesi teaches the method of claim 28 as described above.

Borghesi does not explicitly teach a customer satisfaction index score for a potential assignee.

Brooks teaches associating a customer satisfaction index score with potential vehicle repair

facilities (see column 9, lines 12-13). It would have been obvious to one of ordinary skill in the

art at the time of the invention to incorporate such data into the system of Borghesi. One of

ordinary skill in the art would have been motivated to incorporate such data for the purpose of

enhancing the process of assigning claims to the best automotive repair facilities in Borghesi

(see column 2, lines 50-56 of Brooks).

Conclusion

26.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

- Donovan teaches an automated insurance claim repricing system.

- McCormack teaches automatically identifying and assigning reinsurance claims.

27.   Any inquiry concerning this communication or earlier communications from the examiner

should be directed to Luke Gilligan whose telephone number is (571) 272-6770. The examiner

can normally be reached on Monday-Friday 8am-5:30pm.

28.   If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

29.   Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private

PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

1/19/05

C. LUKE GILLIGAN
PATENT EXAMINER